

REMARKS

Claims 1 to 23 are pending in this application and have been rejected under 35 U.S.C. § 103 as being unpatentable. Reconsideration is requested for each of the pending claims.

Claim Rejections 35 U.S.C. § 103

Applicant acknowledges and appreciates Examiner's reminder of Applicant's obligation under 37 C.F.R. 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made.

Gordon

Claims 1 to 23 were rejected under 35 U.S.C. § 103 by the Examiner as being unpatentable over Gordon. Applicant traverses this rejection because Gordon fails to establish a prima facie case of obviousness with regards to the present invention. Applicant respectfully traverses these rejections for at least the following reasons.

The Examiner states that "the pH of the said composition, a sodium metabisulfite..., aminopropyl ascorbyl phosphate... and sodium ascorbyl phosphate..." are not taught by Gordon.

35 U.S.C. 103(a) sets forth in part:

[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.

Hence, to establish a prima facie case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

Second there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Third, there must be a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). The Gordon reference fails to teach or suggest all the claim limitations in the present application. (See MPEP 706.02(j) (... *the prior art reference (or references when combined) must teach or suggest all claim limitations.*) The

Examiner freely states:

Gordon teaches most critical elements required by the instant claims except the pH of the said composition, a sodium metabisulfite (recited in claims 11-13 and 19-20, amino ascorbyl phosphate (recited in claims 21-22) and a sodium ascorbyl phosphate (recited in claim 23). [emphasis added].

Applicant respectfully submits Gordon does not teach or suggest the use of each of the claimed compounds in a pH specific compound. Since Gordon does not teach the claim limitations of Claim 1 of the present invention as stated hereinabove, Gordon cannot render obvious Claim 1 of the present Application.

In addition, Applicant asserts that dependent Claims 2-23 are likewise in a condition for allowance by virtue of their ultimate dependence on independent Claim 1.

The Examiner has not met her burden of establishing a prima facie case of obviousness using the Gordon reference by failing to provide express support for Examiner's assertion that Gordon provides some suggestion or motivation to substitute the "active agents" or modify the pH (See Paper 15, page #3). Examiner is required to provide express support from the art cited against Applicant, as opposed to merely stating that some suggestion or motivation exists or

would be within the “skilled level of the artisan . . . absent evidence to the contrary.” Id. See MPEP 2144.08.

Thus, the burden of proof is on the Examiner to show, by express fact-findings, that the cited prior art provides the necessary suggestion or motivation required for a proper rejection under §103(a). Gordon not only fails to provide some suggestion or motivation for the substitution of “active agents” or the modification of pH, Examiner’s opinion of the ordinary skill in the art is insufficient to support a rejection under §103(a). Gordon does not teach “manufacturing processes which are efficient (e.g. easy accessibility and cost reduction); and . . . pH [modifications that] less[en] skin irritation [and] reduce side effects” as suggestions or motivations to modify Gordon into Applicant’s claimed invention. Merely reciting that substitutions are “considered to be well within the skilled level of the artisan,” is insufficient evidence for an obviousness rejection.

If the Examiner is relying on facts within Examiner’s personal knowledge, Applicant invites the Examiner to provide an affidavit pursuant to 37 C.F.R. §1.104 (d)(2). Absent such evidence, Gordon does not teach each claim element and does not suggest modifications to achieve Applicant’s claimed invention. The Examiner’s burden has not been met and the rejection should be withdrawn.

Lukenbach et al in view of Gordon

Claims 1 to 9 were rejected under 35 U.S.C. § 103 by the Examiner as being unpatentable over Lukenbach in view of Gordon. Applicant traverses this rejection because Lukenbach, in combination with Gordon, fails to establish a prima facie case of obviousness in regards to the present invention. Applicant respectfully traverses these rejections for at least the following reasons.

Examiner admits:

Applicant's claims differ [from those of Lukenbach et al] in that they require both ingredients together in one final product, and optionally with sodium metabisulfite.

Applicant respectfully submits Lukenbach et al in view of Gordon does not teach or suggest the use of the active agents magnesium ascorbyl phosphate and hydroquinone together in one final product. As discussed immediately above, Gordon, as well as Lukenbach, does not teach the claim limitations of Claim 1, specifically the use of the claimed compounds, together, in the claimed pH range.

Additionally, neither Lukenbach nor Gordon addresses additional problems solved by the present invention, including the discoloring and/or oxidation of the Applicant's composition. Applicant submits that the stability of Applicant's composition, the combination of the claimed compounds in the specified pH range, is a result unexpected by those skilled in the art. MPEP § 716.05(b) states:

Evidence of unexpected properties may be in the form of a direct or indirect comparison of the claimed invention with the closest prior art which is commensurate in scope with the claims. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Applicant respectfully submits Lukenbach in conjunction with Gordon, fails to teach the cosmetically acceptable combination of the active agents at the given pH, a problem addressed by the present invention. As stated in the attached Declaration by Philip J. Gordon (attached as Exhibit 1), a named inventor, laboratory preparations of example compositions, prepared according to Lukenbach, separately containing magnesium ascorbyl phosphate and hydroquinone, both at a pH of 7.5, do not present viable cosmetic formulations. Specifically, example 100B of Lukenbach, containing magnesium ascorbyl phosphate, began to brown and

separate within days after mixing and additionally showed flocculation after a mere two weeks. (see Gordon Declaration, paragraph 4 and Exhibit A). While example 100C also discolored within days of mixing, and further exhibited signs of hydroquinone degradation within the first two weeks after mixing. (see Gordon Declaration, paragraphs 6 and 7 and Exhibit B). Cosmetic formulations must be stable and aesthetically pleasing. As seen in the photograph at Exhibit A of the Gordon Declaration, Lukenbach Example 100B is brown and not aesthetically pleasing. Exhibit B of the Gordon Declaration is a photograph of Luckenbach Example 100C, which is discolored, separated and not aesthetically pleasing either. Neither example 100B nor 100C in Lukenbach were cosmetically or aesthetically acceptable and showed degradation of the actives. One of ordinary skill in the art would not expect the combination of the active agents in these unstable formulations to result in a stable, cosmetically pleasing formulation. Thus, as compared to Lukenbach's embodiments, the stability and resulting pleasing aesthetics of the present invention are unexpected in the applicant's invention and is not rendered obvious by Lukenbach et al and Gordon.

Since Lukenbach fails as a reference under 35 U.S.C. §103 as stated hereinabove, Lukenbach cannot render obvious Claim 1 of the present Application. Since neither Lukenbach et al nor Gordon, alone or in combination, teach all of the claim limitations of Claim 1 of the present invention as stated hereinabove, the combination Lukenbach and Gordon cannot render obvious Claim 1 of the present Application. MPEP 706.02(j)

Consequently, Applicant traverses the 35 U.S.C. §103(a) rejections and respectfully requests their reconsideration and removal. Applicant asserts that independent Claim 1 is in a condition for allowance.

In addition, Applicant asserts that dependent Claims 2-23 are likewise in a condition for allowance by virtue of the ultimate dependence on independent Claim 1.

Conclusion

Applicant respectfully requests reconsideration of the present application in light of the reasons set forth herein, and a Notice of Allowance for all pending claims is earnestly solicited.

Should there be any fees due and owing with respect to this response, the Examiner is authorized to charge such fees to Deposit Account No. 18-0586.

Express Mail Label No. EV 342396577US
Date of Deposit Oct. 23, 2003


I hereby certify that this paper or fee is being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to Commissioner for Patents, P. O. Box 1450, Alexandria, VA 22313-1450

Tamica Catling-Jones
(Typed or Printed name of person mailing paper or fee)

Tamica Catling-Jones
(Signature of person mailing paper or fee)

Respectfully submitted,

REED SMITH LLP



Edward F. Behm Jr.
Registration No. 52,606
Maryellen Feehery
Registration No. 44,677
2500 One Liberty Place
1650 Market Street
Philadelphia, PA 19103-7301
(215) 241-7988
Attorneys for Applicant